THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FREDERICK A. NABITY, PAUL G. WRIGHT, RAYMOND HULINSKY and DOUGLAS T. CARSON

Appeal No. 1996-2795
Application No. 08/430,155[1]

HEARD: November 2, 1999

Before HAIRSTON, RUGGIERO, and HECKER, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

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[1] Application for patent filed April 26, 1995. According to appellants, the application is a continuation of Application No. 08/120,724, filed September 13, 1993, now abandoned; which is a division of Application No. 07/807,200, filed December 16, 1991, now U.S. Patent No. 5,401,139, issued March 28, 1995; which is a division of Application No. 07/474,154, filed February 2, 1990, now U.S. Patent No. 5, 125,801, issued June 30, 1992.

This is an appeal from the final rejection of claims 2 through 5. In an Amendment After Final (paper number 19), non-elected claim 1 was canceled, and claim 2 was amended.

The disclosed invention relates to a sensor that uses a strain-sensitive film in contact with a flexible conduit. The sensor housing for the conduit and the strain-sensitive film permits the conduit to expand when liquid is pumped through the conduit, and the expansion of the conduit is detected by the strain-sensitive film.

Claim 2 is the only independent claim on appeal, and it reads as follows:

2. A sensor including:

a flexible conduit;

housing means for receiving the flexible conduit and the strain-sensitive film;[2]

said housing means including film and conduit support means for supporting the film at a location adjacent to the conduit support means wherein at least a portion of the strain-sensitive film will be in contact with the conduit when the housing and conduit are assembled;

means for permitting sufficient expansion of the conduit to create strain of an amplitude to permit discrimination of

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[2]We note in passing that claim 2 lacks antecedent basis for "the strain-sensitive film."

signal from noise whereby said strain-sensitive film is partly stretched in the housing means for receiving a flexible conduit;

electrical connections to the strain-sensitive film adapted to sense periodic strains whereby liquid pumped through the conduit may be detected;

said conduit support means including first means for receiving a first portion of the conduit and second means for receiving a second portion of the conduit spaced from the first portion of the conduit whereby the conduit support means may have a loop of conduit extending from it to cooperate with a peristaltic pump.

The reference relied on by the examiner is:

Krempl et al. (Krempl) 4,391,147 July 5, 1983

Claims 2 through 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Krempl.

Reference is made to the brief and the answer for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the 35 U.S.C. § 102(b) rejection of claims 2 through 5. As indicated infra, a new ground of rejection of claims 2 through 5 has been entered under the provisions of 37 CFR § 1.196(b).

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either expressly or inherently. See Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995).

With respect to claim 2, appellants argue (Brief, page 10) that Krempl "does not disclose a support means which includes two separate means for receiving different spaced apart portions of a conduit which allow the conduit support means to have a loop of conduit extending from it to cooperate with a peristaltic pump." Krempl does not disclose a pump of any kind, and the examiner has not addressed the lack of such a teaching in Krempl. Thus, the 35 U.S.C. § 102(b) rejection of claims 2 through 5 is reversed because every limitation of the claimed invention is not taught by Krempl.[3]

[3] Even if a pump was disclosed by Krempl, we would still have to reverse the prior art rejection of claims 2 through 5 because the word "may" conveys to the reader that claim 2 does not positively include a loop of conduit extending from the conduit support means or a peristaltic pump. Inasmuch as we are not able to determine whether or not the loop of conduit and the pump are in a cooperative relationship with the sensor, we are not able to determine the metes and bounds of the claimed invention. A prior art rejection should be reversed when resort to speculation and assumptions are necessary to apply the prior art to limitations of the claim. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295

REJECTION UNDER 37 CFR § 1.196(b)

Pursuant to the provisions of 37 CFR § 1,196(b), we hereby enter the following new ground of rejection:

Claims 2 through 5 are rejected under the second paragraph of 35 U.S.C. § 112 because of the use of the word "may" in claim 2. The claims are indefinite because the loop of conduit extending from the conduit support means and the peristaltic pump are not positively included in a cooperative relationship with the sensor. As a result thereof, the metes and bounds of the claimed invention can not be determined with any degree of certainty.

DECISION

The decision of the examiner rejecting claims 2 through 5 under 35 U.S.C. § 102(b) is reversed.

As indicated supra, a new ground of rejection of claims 2 through 5 has been entered under the provisions of 37 CFR

(CCPA 1962).

§ 1.196(b). According to 37 CFR § 1.196(b), "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED

37 CFR § 1.196(b)

KENNETH W. HAIRSTON Administrative Patent Judge	)	
JOSEPH F. RUGGIERO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
STUART N. HECKER Administrative Patent Judge	)	

lp

Appeal No. 1996-2795
Application No. 08/430,155

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Appeal No. 96-2795
Application No. 08/430,155

APJ HAIRSTON

APJ HECKER

APJ RUGGIERO

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): _____

Prepared: July 20, 2000

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT